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Zauderer *et al.*
Appl. No. 09/987,456***Remarks***

Upon entry of the foregoing amendment, claims 84-131 are pending in the application, with claims 84, 126, and 127 being the independent claims. Claims 1-83 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 84-131 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Support for new claims 84-131 is found throughout the specification and claims as originally filed.

Reply to Restriction Requirement

In reply to the Office Action dated **September 10, 2003** (PTO Prosecution File Wrapper Paper No. 9), requesting an election of one group of claims to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the claims of Group I. It is believed that new claims 84-106, 113-122, and 129-131 fall within this group. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to pursue the nonelected claims in one or more divisional applications.

This election is made **with** traverse.

With respect to the Examiner's division of the claims into five groups and the reasons stated therefor, Applicants respectfully traverse. Each of the groups is related. For example, Groups I, II, and III are related as between a method of selecting from libraries of polynucleotides which encode an antigen-specific immunoglobulin molecule

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(Group I), a method of constructing a library of polynucleotides which encode immunoglobulin subunit polypeptides (Group II), and a kit for selecting antigen-specific immunoglobulins from libraries of polynucleotides (Group III). Groups I-III are related to Group IV as between a method, and an immunoglobulin produced by that method. Likewise, Groups IV and V are related as between an antibody produced by a method of selecting polynucleotides which encode an antigen-specific immunoglobulin (Group IV) and a composition comprising an antibody produced by a method of selecting polynucleotides which encode an antigen-specific immunoglobulin and a pharmaceutically acceptable carrier (Group V).

Even assuming, *arguendo*, that Groups I-V represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of these Groups together would not be a serious burden on the Examiner. In particular, any art related to a method of selecting from libraries of polynucleotides polynucleotides which encode an antigen-specific immunoglobulin molecule is very likely to overlap substantially with art related to a method of constructing a library of polynucleotides which encode immunoglobulin subunit polypeptides, and a kit for selecting antigen-specific immunoglobulins from libraries of polynucleotides. Similarly, art related to an antibody produced by a method of selecting polynucleotides which encode an antigen-specific immunoglobulin is very likely to substantially overlap with art related to a composition comprising an antibody produced by a method of selecting polynucleotides which encode an antigen-specific immunoglobulin and a pharmaceutically acceptable carrier. Accordingly, it would not be an undue burden for the Examiner to search, at a

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minimum, Groups I, II, and II together, and Groups IV and V together. The M.P.E.P.

§803 (Eighth Edition, Rev. August, 2001) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. §803, Applicants respectfully request that all claims be searched and examined in the subject application. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

The Examiner has also required a large number of species elections. Applicants' provisional elections are listed below, along with a listing of each of the new claims believed to read on each of the provisionally-elected species.

These elections are made **with** traverse.

Subgroup 1. The Examiner has required an election of species among host cells. Applicants hereby provisionally elect to prosecute the species comprising a HeLa cell which is permissive for the production of infectious viral particles. New claims 84-131 are generic to the provisionally elected species.

Subgroup 2. The Examiner has required an election of species among immunoglobulin sources. Applicants hereby elect to prosecute the species comprising a human immunoglobulin. New claims 84-131 specifically recite the elected species.

Subgroup 3. The Examiner has required an election of species among immunoglobulins. Applicants hereby provisionally elect to prosecute the species comprising a secreted form of immunoglobulin. New claims 84-112 and 123-131 are

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generic to the provisionally elected species. New claims 113-122 specifically recite the provisionally elected species.

Subgroup 4. The Examiner has required an election of species among immunoglobulin types. Applicants hereby provisionally elect to prosecute the species comprising an IgG immunoglobulin, or fragment thereof. New claims 84-131 are generic to the provisionally elected species. Under this subgroup, the Examiner appears to require Applicants to elect a portion of an immunoglobulin, *i.e.*, either a heavy chain or a light chain. In order to be fully responsive, Applicants would provisionally elect to prosecute the species comprising an IgG heavy chain, or fragment thereof. However, each of the new claims recite complete, bivalent immunoglobulins, or antigen-specific fragments thereof, which comprise heavy chain *and* light chain. Accordingly, no claims are generic to an immunoglobulin comprising *just* a heavy chain or *just* a light chain.

Subgroup 5. The Examiner has required an election of species among species of first and second library construction. Applicants hereby elect to prosecute the species comprising a vaccinia virus for both first and second library construction. New claims 84-128 specifically recite the elected species.

Subgroup 6. The Examiner has required an election of species among promoters. Applicants hereby provisionally elect to prosecute the species comprising a T7 promoter. New claims 84-99, 104-107, 109, 110, and 112-131 are generic to the provisionally elected species. New claim 103 specifically recites the provisionally elected species.

Subgroup 7. The Examiner has required an election of species among detection methods. Applicants hereby provisionally elect to prosecute the species comprising detecting by ELISA. New claims 84-120 and 123-131 are generic to the provisionally

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elected species. New claims 121 and 122 specifically recite the provisionally elected species.

Subgroup 8. The Examiner has required an election of species among antigen attachment. Applicants hereby provisionally elect to prosecute the species comprising attachment to a solid surface, such as a well of an ELISA plate. New claims 84-120 and 123-131 are generic to the provisionally elected species. New claims 121 and 122 specifically recite the provisionally elected species.

Applicants respectfully traverse and request the withdrawal of the requirement for election of species. As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represent patentably distinct species, restriction remains improper unless it can be shown that the search and examination of the listed groups would entail a "serious burden." See M.P.E.P. § 803. In the present situation, no such showing has been made. For example, although the Examiner has asserted that embodiments referring to immunoglobulins are distinct species, Applicants submit that a search of IgG as an immunoglobulin would provide useful information regarding other types of immunoglobulin, such as IgM.

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Similarly, the search and examination of all of the claims of Group I would not entail a serious burden.

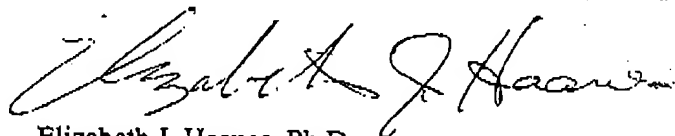
Applicants assert the right to claim additional embodiments in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a). Reconsideration and withdrawal of the Requirement for Election of species, and consideration and allowance of all pending claims, are respectfully requested.

Summary

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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